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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,981	04/20/2005	Jordi Tormo i Blasco	5000-0115PUS1	5810

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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MURRAY, JEFFREY H

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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01/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,981	<b>Applicant(s)</b> BLASCO ET AL.	
	<b>Examiner</b> Jeffrey H. Murray	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6, 10 and 11 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-3, 5, 6, 8, and 9 are rejected. Claim 7 is withdrawn.
1. Claims 1-6, 10, and 11 are pending in this application. Claims 7-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method claims, there being no allowable generic or linking claim. This action is in response to the applicants' amendment after a non-final and reply filed on September 27, 2007.

### ***Status of Objections***

3. The specification was objected to as not indicating the proper section headings. The objection to the specification is hereby withdrawn in view of applicants' amendments to the specification.

### ***Status of Rejections***

4. Claims 1-6 and 9 are rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as failing to comply with the definiteness requirement. The rejection of Claims 1-6 and 9 are hereby withdrawn in view of applicants' amendments to Claims 1 and 2.
5. Claim 8 is rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph and U.S.C. 101 as being a "use" claim. The rejection of Claim 8 is hereby withdrawn in view of applicants' amendment to Claim 8 converting it into a method claim.
6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b), as failing to comply with the novelty requirement. The rejection of Claims 1-3 and 6 are hereby moot and withdrawn in view of interview with applicant on August 8, 2007. It was determined that

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the argued compound, R.N. 856864-33-0, of U.S. Patent No. 2,444,605 was NOT “expressly taught” in the reference and therefore the reference cannot be used for the prior art teaching of this particular compound. Claim 5 continues to be anticipated by U.S. patent No. 2,444,605 under 102(b), see below.

7. Claim 1 is provisionally rejected under nonstatutory double patenting, in light of U.S. Patent Publication No. 2005/0261314. The rejection of Claim 1 is hereby withdrawn in view of applicants’ amendment to Claim 1.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

1. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "compound" in Claim 4. There is insufficient antecedent basis for this limitation in the claim. Claim 5 cannot depend from Claim 4 because Claim 4 is a non-elected claim. Claim 4 also is a “method” claim and cannot be depended on by the “compound” claim of Claim 5.

#### ***Claim Rejections - 35 USC § 102***

9. Claim 5 *continues* to be rejected under 35 U.S.C. 102(b) as being anticipated by Heimbach et. al.; US Patent No. 2,444,605 which was published on July 6, 1948. The instantly claimed compounds of formula III read on the reference compound, RN

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856864-36-3. See the enclosed STN search and the highlighted compounds, i.e., a compound of the formula (III) which is a 7-hydroxytriazolopyrimidine where the corresponding X is a methyl group and the R<sup>3</sup> group is a cyclohexyl group.

***Allowable Subject Matter***

10. Claims 1-4, 6, 10, and 11 are allowed.

11. Claims 1-4, 6, 10, and 11 are considered allowable because there is no prior art that describes the 7-aminotriazolopyrimidines of the present invention. The closest prior art is Heimbach et. al.; US Patent No. 2,444,605, however the prior art does not teach the synthesis of a 7-aminotriazolopyrimidine where the corresponding X variable is an alkyl group and the R<sup>3</sup> variable is a cycloalkyl or bicycloalkyl group.

***Conclusion***

10. Claim 5 is rejected.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Examiner, Art Unit 1624

/James O. Wilson/  
Supervisory Patent Examiner  
Art Unit 1624